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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/404,010	09/23/1999	YING LUO	A-68294/DJB/	7948

7590

06/28/2002

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EXAMINER

ANDRES, JANET L

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 06/28/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/404,010

Applicant(s)

LUO ET AL.

Examiner

Janet L Andres

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 June 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 06 June 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

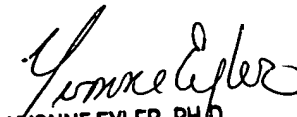
Claim(s) objected to: _____.

Claim(s) rejected: 24-33.Claim(s) withdrawn from consideration: 11-23.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that knowing that Mkinase is somehow involved in the cell cycle is sufficient to enable one of skill to make and use it to screen for modulators of the cell cycle. Applicant further argues that such screening assays have a real-world utility. Applicant additionally points to the Revised Utility Guidelines and argues that the office action provides no evidence to refute the teachings of Xu or to suggest that the asserted function is not credible or that the invention is inoperative. Applicant further argues that one of skill "would look for changes in the cell cycle to reflect changes in Mkinase activity". Applicant states that both antagonists and agonists are desired. Applicant states that knowledge of the precise function of Mkinase is not critical to the performance of screens for alterations in the cell cycle.

Applicant's arguments have been fully considered but, for reasons of record in the office action of paper no. 18, are not found persuasive. The utility of Applicant's invention has not been challenged, nor has the credibility of Applicant's assertions. However, what is asserted is, as stated previously, that Mkinase is somehow involved in the cell cycle. What is not disclosed, and what one of skill would not be able to determine from the instant disclosure, is how it is involved. Thus, contrary to Applicant's assertions, the artisan would not know how to use it to screen for modulators, because such an artisan would not know what activity would be expected to be modulated. Applicant has provided no guidance to allow one of skill in the art to determine, without undue experimentation, whether activation or inhibition, or a more complex form of modulation, is to be expected. The artisan would not know what was to be measured or how such measurements would be affected. Thus, one of skill would have to determine precisely how Applicant's invention functioned in order to use it. While art-recognized screens are provided by the specification, absent knowledge of the activity to be affected, this is not sufficient guidance to allow one of skill to predictably use Mkinase for any purpose, but is merely an invitation to use the current invention as a starting point for further experimentation. Thus, without further guidance, it would require undue experimentation for the skilled artisan to practice Applicant's invention.


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